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UNITED STATES DISTRICT COURT

DISTRICT OF ARIZONA

First Service Networks, Inc.,

Plaintiff,

vs.

First Service Maintenance Group, Inc.,

Defendant.

No. 2:11-CV-01897-DGC

**JOINT STATUS REPORT AND
DISCOVERY PLAN**

(The Honorable David G. Campbell)

Case Management Conference

Date: October 5, 2012

Time: 4:30 PM

Courtroom: 603

Pursuant to the Court's August 9, 2012 Order (D.I. 42), and in accordance with Fed. R. Civ. P. 26(f) and 16(c), counsel for the parties, First Service Networks, Inc., ("FSN") and First Service Maintenance Group, Inc., ("FSMG") have conferred and submit this Joint Status Report and Proposed Discovery Plan.

1 **1. 26(f) CONFERENCE ATTENDEES**

2 Pursuant to the Court's Order, the parties conferred telephonically on September 25,
3 2012. Kevin M. Bovard of Woodcock Washburn LLP attended the conference for FSN;
4 attending for FSMG was Kenneth Motolenich-Salas of Weiss & Moy, P.C.

5 **2. PARTIES**

6 Plaintiff: First Service Networks, Inc., which has a majority shareholder, Thunder
7 Basin Corporation. (*See* Corporate Disclosure Statement, D.I. 3.)

8 Defendant: First Service Maintenance Group, Inc.


9 Both parties are in the business of managing maintenance and repairs for multi-site
10 businesses and facilities.

11 **3. STATEMENT OF THE NATURE OF THE CASE**

12 Plaintiff's Claims:

13 FSN filed suit against FSMG asserting federal and state law claims for trademark
14 infringement, unfair competition, unjust enrichment, and anticybersquatting. *See*
15 Complaint, D.I. 1. These claims concern U.S. Trademarks 2,737,643 (registered July 15,
16 2003) and 2,942,344 (registered April 19, 2005), both of which are owned by FSN. *Id.*

17

Trademark	Registration Number	Registration Date	Goods/Services
FIRST SERVICE NETWORKS	2,737,643	July 15, 2003	(Int. Cl. 35) Technical facilities management services.
FIRST SERVICE NETWORKS & DESIGN  First Service Networks	2,942,344	April 19, 2005	(Int. Cl. 35) Technical facilities management services.

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24 FSN alleges continuous use of these Marks since their registration dates, and that
25 these Marks are thus incontestable pursuant to 15 U.S.C. §1065. *Id.*

26 FSN contends that FSMG is infringing on its registered trademarks by using marks
27 incorporating the words "First Service," "1st Service," "1st Service Maintenance," and
28

1 “First Service Maintenance Group, Inc.” *Id.*

2 Defendant’s Response to Plaintiff’s Claims:

3 Defendant contends in its Answer that Plaintiff cannot demonstrate any likelihood
4 that the public will be confused, mistaken, deceived, or misled as to the source of
5 Defendant’s services or that Defendant’s services are associated with or endorsed by
6 Plaintiff. (D.I. 45.) Moreover, Defendant asserts that the Plaintiff’s marks are generic
7 and/or lack any secondary meaning, inherent distinctiveness, or acquired distinctiveness
8 and thus are not entitled to trademark protection. In addition, Defendant asserts various
9 affirmative defenses, including, inter alia, fair use pursuant to 15 U.S.C. 1115(b)(4),
10 innocent use of mark pursuant to 15 U.S.C. 1115(b)(5), no bad faith intent to profit from
11 registration or use of its website, no registration or use of any website that is identical or
12 confusingly similar to any of Plaintiff’s marks, no damages or harm suffered by Plaintiff,
13 and no willfulness on the part of Defendant in taking any of the alleged actions.

14 Defendant’s Counterclaims:

15 In addition to responding to Plaintiff’s claims, Defendant, in its Answer, asserts
16 counterclaims of (1) Declaratory Judgment of Non-infringement of Federal Trademarks,
17 (2) Declaratory Judgment of No Federal Unfair Competition, (3) Declaratory Judgment of
18 No Cybersquatting, (4) Declaratory Judgment of Federal Trademark Invalidity, (5)
19 Declaratory Judgment of Genericness, (6) Cancellation of Plaintiff’s Marks, (7)
20 Amendment of Trademark Registrations, (8) Declaratory Judgment of State Trademark
21 Invalidity, (9) Declaratory Judgment of Non-infringement of State Marks, (10)
22 Declaratory Judgment of No Arizona Unfair Competition, and (11) Declaratory Judgment
23 of No Unjust Enrichment. *See* Answer, D.I. 45.

24 Plaintiff’s Response to Defendant’s Counterclaims:

25 FSN contends that Counterclaims 4-7 are improper as a matter of law, and that
26 Counterclaims 4-8 fail to meet the pleading standards set forth by the Supreme Court in
27 *Iqbal* and *Twombly*. FSN filed a Motion to Dismiss Counterclaims 4-8 from Defendants’
28 Answer, which motion is currently pending before the Court. *See* D.I. 47. Irrespective of

1 FSN's Motion to Dismiss, FSN asserts that none of FSMG's counterclaims has merit.

2 **4. JURISDICTIONAL BASIS FOR THE CASE**

3 This is an action arising under Sections 32 and 43 of the Trademark Act of 1946, as
 4 amended, commonly known as the Lanham Act, 15 U.S.C. §§ 1114, 1125, and under the
 5 laws of the State of Arizona. This Court has jurisdiction over the subject matter of this
 6 action pursuant to 15 U.S.C. §§1121 and 1125, as well as 28 U.S.C. §§1331, 1332, 1338,
 7 and 1367 because it involves substantial claims arising under the Lanham Act (15 U.S.C. §
 8 1051 *et seq.*). Additionally, the Court has determined that its exercise of personal
 9 jurisdiction over Defendant FSMG is proper. *See* Order Denying Motion to Dismiss,
 10 D.I. 41.

11 **5. SERVICE ON DEFENDANT**

12 FSMG, the sole Defendant in this action, was served on Jan. 12, 2012. *See*
 13 Affidavit of Service, D.I. 12.

14 **6. ADDITIONAL PARTIES**

15 Neither FSN nor FSMG anticipates joining additional parties at this time, but agree
 16 that any additional parties should be joined by November 2, 2012.

17 **7. EXPEDITED TRIAL**

18 The parties do not elect to participate in the Expedited Trial Alternative. Counsel
 19 for Defendant and Plaintiff certify that they discussed the expedited trial option, including
 20 the potential cost savings of an expedited trial, with their clients, as required in the Order
 21 Setting Rule 16 Case Management Conference. (D.I. 42 at ¶ B.) Despite declining this
 22 option, the parties do request an early Settlement Conference with a Magistrate Judge, as
 23 discussed *infra*.

24 **8. CONTEMPLATED MOTIONS**

25 Currently pending before the Court is FSN's Motion to Dismiss FSMG's
 26 Counterclaims (D.I. 47). At present, the only additional motions anticipated by the parties
 27 are summary judgment motions after the close of discovery, with the parties reserving the
 28 right to file motions in limine if there is good cause for such motions.

9. MAGISTRATE JUDGE

The parties believe this case is suitable for referral to a U.S. Magistrate Judge for an early settlement conference. The parties agree that such settlement conference would be appropriate within the first two months of fact discovery. The parties decline referral of this case to a U.S. Magistrate Judge for trial.

10. RELATED CASES

There are no pending cases in this Court or elsewhere related to this matter.

11. DISCLOSURE & DISCOVERY OF ELECTRONICALLY STORED INFORMATION

The parties have taken steps to preserve relevant electronically stored information. (“ESI”). The parties agree that during fact discovery, ESI shall be subject to search and review in the context of responding to requests for production of documents and interrogatories. The parties will work to negotiate an agreeable form of production for electronic information. The parties will negotiate the terms of a stipulated Protective Order that is necessary due to the confidential technical and business information that will be exchanged in this action. The parties expect in the near future to present to the Court a proposed form of stipulated order for the Court’s consideration.

12. CLAIMS OF PRIVILEGE OR WORK PRODUCT

FSN and FSMG agree that, upon making a claim of privilege as a basis for withholding or redacting any document, the withholding party shall produce an appropriate privilege log identifying such document(s).

As noted, the parties will negotiate the terms of a stipulated Protective Order. Such Protective Order shall include a provision that any inadvertently produced, privileged documents shall not constitute a waiver of any applicable privilege in this action. The producing party must notify the receiving party in writing immediately upon discovering that the document was inadvertently produced; the receiving party shall then, within five (5) days, destroy all copies of the inadvertently produced document, unless the receiving

1 party intends to immediately challenge such claim of privilege. The parties agree that the
2 foregoing provision does not preclude any party from contesting the claim of privilege.

3 **13. FED. R. EVID. 502(d) ORDER**

4 The parties intend to submit a stipulated Protective Order that includes a provision
5 governing inadvertent disclosure of privileged documents, as anticipated by Fed. R. Evid.
6 502(d).

7 **14. DISCOVERY PLAN**

8 **A. Extent, nature, and location of discovery**

9 The parties anticipate conducting discovery into all allegations raised in the
10 Complaint, including but not limited to:

- 11 1. the selection, registration, and use of the parties' trademarks and
12 business names at issue in the Complaint;
- 13 2. the selection, registration, and use of the <http://www.1stmng.com>
14 domain;
- 15 3. the nature of the parties' businesses;
- 16 4. likelihood of confusion relating to Plaintiff's Marks and FSMG's use
17 of the "First Service" name;
- 18 5. instances of actual confusion relating to Plaintiff's Marks and
19 FSMG's use of the "First Service" name;
- 20 6. damages incurred as a result of the acts raised in Plaintiff's
21 Complaint.

22 The parties also anticipate conducting discovery into the allegations raised in
23 FSMG's counterclaims, to the extent such counterclaims are not dismissed, including but
24 not limited to the validity of Plaintiff's Marks. (*See* D.I. 45, 47.)

25 The parties will reasonably cooperate in scheduling dates and locations for
26 depositions.

B. Suggested changes, if any, to the discovery limitations imposed by the Federal Rules of Civil Procedure

None.

C. The number of hours permitted for each deposition.

Seven (7) hours per fact deposition.

15. INITIAL DISCLOSURES

Initial Disclosures will be served on or before October 9, 2012.

16. DISCOVERY DEADLINE

- a. Fact discovery should be completed by April 5, 2013.
- b. Expert disclosures pursuant to Rule 26(a)(2) should be made by May 3, 2013, on any issues for which a party will bear the burden of proof. Rebuttal expert disclosures, limited to responding to opinions set forth in initial expert disclosures, shall be made by June 7, 2013.
- c. Expert Discovery, including expert depositions, should be completed by July 12, 2013.
- d. The parties shall engage in good faith settlement talks on or before December 21, 2012
- e. Dispositive motions shall be filed on or before August 16, 2013.

17. JURY TRIAL

Both parties have demanded a jury trial on all issues that are triable by jury. The parties estimate that three trial days will be required for trial.

18. SETTLEMENT

The parties request an early settlement conference with a U.S. Magistrate Judge.

19. OTHER MATTERS

None.

1 DATED this 28th day of September, 2012.

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CERTIFICATE OF SERVICE

I hereby certify that on September 28, 2012, I electronically transmitted this document to the Clerk's office using the ECF System for filing and transmittal of a Notice of Electronic Filing to the following ECF registrants:

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